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09/875,460

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Dan Kikinis

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EXAMINER

SALCE, JASON P

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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/875,460 | Applicant(s) KIKINIS, DAN | |
| | Examiner Jason P. Salce | Art Unit 2421 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,14-16 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,14-16 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/2010 has been entered.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 7/9/2010 and 1/14/2011 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-11, 14-16 and 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-28 recite, “**a machine readable storage medium storing computer executable instructions for**”.

A “machine readable storage medium” could include a signal per se, new policy has been issued by Director of the U.S. Patent and Trademark Office, David J. Kappos regarding this issue and states the following:

“The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. *Cf. Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation “non-human” to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).”

Therefore, since the broadest reasonable interpretation relies on the ordinary and customary meaning, which includes signals per se in regards to a machine readable medium, the Examiner advises Applicant to amend the claims to recite “**non-transitory** machine readable storage medium” in the claim.

Claims 1-3, 6-11, 14-16 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 9 have been amended to recite, “**indicating on the first web phone, based on the displayed electronic program guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide**”. No support is found in the specification of the instant application for these claim limitations (**or in the provisional applications**).

Applicant notes that support for the claimed limitations are found in application 09/488,361 now Patent No. 6,421,067. The Examiner has found the section entitled "Help Mode" at Column 11, Line 25 through Column 12, Line 13. While this portion of the '067 Patent discloses an EPG that indicates which buttons on a remote control device are appropriate for performing functions for the EPG, the '067 Patent fails to teach that a first web phone is used as a remote control device. The Examiner further notes that the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG. Therefore the '067 Patent fails to provide support for the claims.

Referring to claims 6-7 and 14-15, the specification fails to teach communication between multiple web phones.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-11, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Nobakht et al. (U.S. Patent No. 6,745,223).

Referring to claim 1, Ellis receiving, via the Internet, an electronic programming guide at a remote program guide access device (**see Paragraph 0097**).

Ellis also discloses displaying the electronic program guide on the remote program guide access device (**see Paragraphs 0110-0112 and Figure 7**).

Ellis also discloses receiving, at the remote program guide access device, a selection associated with the electronic programming guide (**see Paragraph 0113 for allowing the user to select a television program listing**).

Ellis also discloses transmitting the selection to a display device different from the remote program guide access device (**see Paragraph 0098**).

Ellis is silent as to the EPG selection being entered via a web-enabled cellular phone.

Ellis ('**926 Patent**) discloses a cellular phone 42 with display 100, wherein the display 100 is used to display and select EPG items (**see Column 7, Lines 18-26 and Column 8, Lines 60-67**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to combine the systems of Ellis and Ellis ('**926 Patent**) in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extended functionality and control and allowing the user to reserve programs from remote locations. Also note that Ellis ('**926 Patent**) specifically states that an advantage to the system allows the cell phone to access the schedule information and perform various functions, such as searching for programming of interest, establishing favorite programs, setting reminders and setting parental controls (**see Column 1, Lines 40-46 of the '926 Ellis Patent**).

Ellis and Ellis ('**926 Patent**) are silent as to the EPG including an indication of which web-enabled cellular phone buttons are appropriate for the EPG. While Ellis ('**926 Patent**) teaches the use of a web-enabled cellular phone to make EPG selections, neither Ellis reference teaches indicating to the user which buttons can be used for a particular set of functions.

Yoshida discloses an EPG that displays an image of the remote control the viewer is using (**see Figure 7**). The remote control image on the display further provides an indication to the user each key's functionality when a user presses the key

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on the remote control (**see Figures 7-9 and Column 6, Line 30 through Column 8, Line 29**).

Further note that the Yoshida reference discloses displaying a help screen that indicates which buttons a remote control device that are appropriate for performing functions for the EPG (**see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG**).

Therefore Yoshida teaches indicating on a remote control, based on the displayed electronic programming guide, that at least one button of the remote control is appropriate for performing an action associated with the electronic programming guide

At the time the invention was made, it would have obvious to a person of ordinary skill in the art, to modify the EPG accessed by a web-enabled cellular phone, as taught by Ellis and Ellis (**'926 Patent**), using the instructional control keys interface, as taught by Yoshida, for the purpose of allowing a user to easily know the function of the keys even through he/she loses or misplaces the manual for the device (**see Column 2, Lines 55-57 of Yoshida**).

Ellis, Ellis '926 and Yoshida fail to teach that the remote access remote control/cellular phone is a web phone.

Nobakht discloses that remote control 130-C contains a display screen and can be a web phone (**see Figure 1 and Column 17, Lines 9-14**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the cellular phone remote program guide access device, as taught by Ellis, Ellis '926 and Yoshida, using the web phone, as taught by Nobakht, for the purpose of providing an Internet access system that is significantly less expensive than personal computers, and is as easy to use as a television (**see Column 1, Lines 53-55 of Nobakht**).

Referring to claims 2 and 3, Ellis discloses transmitting selections from the remote program access device 24 to a broadcast server and set top box (**Figure 6a for a remote program access device being connected to a set top box 22 through broadcast server 126, therefore any command must be transmitted to a broadcast server and then to the set top box**).

Referring to claims 9-11, see the rejection of claims 1-3, respectively. In regards to claim 9, further note that Ellis discloses that the EPG can also be displayed on the second video display associated with the television (**see Paragraph 0071**).

Referring to claim 28, Yoshida further discloses displaying an indication in the EPG for which buttons are appropriate (**see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG**).

Referring to claim 30, see the rejection of claim 28.

Claims 6-7 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Nobakht et al. (U.S. Patent No. 6,745,223) in further view of Cooper et al. (U.S. Patent No. 6,754,904).

Referring to claim 6, Ellis, Ellis (**'926 Patent**), Yoshida and Nobakht disclose all of the limitations of claim 1, where Ellis (**'926 Patent**) teaches the use of a web-enabled cellular phone in place of a remote control to select television programs in an EPG (**see above**), but are silent as transmitting the selection over the Internet to a second web phone different from the first web phone.

Cooper discloses a plurality of client devices that are capable of selecting television programs to view (**see Figure 5**). Cooper further discloses making EPG selection (**see Figure 7 for using the EPG of Figure 6**) and transmitting the selections over the Internet to multiple client devices (**see Figures 7-11 and Column 2, Lines 45-47 and Column 5, Line 54 through Column 7, Line 59**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the web-enabled cellular phones, as taught by Ellis, Ellis (**'926 Patent**), Yoshida and Nobakht, using the chat enabled client devices, as

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taught by Yoshida, for the purpose of informing a first network user of activity by other network users, thereby allowing users to know what television programs his/her friends are watching (**see Column 2, Lines 39-41 of Cooper**).

Claim 7 corresponds to claim 6, where Cooper further discloses transmitting the selections over the Internet to multiple client devices to be displayed to all users (**concurrently**) while in a chat room (**see Figures 7-11 and Column 2, Lines 45-47 and Column 5, Line 54 through Column 7, Line 59**).

Referring to claims 14-15, see the rejection of claims 6-7, respectively.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Nobakht et al. (U.S. Patent No. 6,745,223) in further view of Terakado et al. (U.S. Patent No. 6,246,441).

Referring to claim 8, Ellis and Ellis ('926 Patent), Yoshida and Nobakht disclose all of the limitations of claim 6, as well as Nobakht teaching that each user uses a web phone, but are silent as to transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

Terakado discloses (**in the same field of endeavor**) a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal (**see Column 9, Lines 47-53**). **The Examiner has further cited Grooters (U.S. Patent No. 6,862,741) for further teaching these limitations.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the systems of Ellis, Ellis (**'926 Patent**), Yoshida and Nobakht, using the teachings of Terakado in order to provide a system capable of allowing a user to watch a broadcast program on the television receiver 9, while checking programs to be broadcast from a time onward by using an EPG without obstructing the display of the television receiver 9 (**see Column 9, Lines 50-53 of Terakado**).

Referring to claim 16, see the rejection of claim 8.

Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Nobakht et al. (U.S. Patent No. 6,745,223) in further view of Dustin (U.S. Patent No. 6,853,308).

Referring to claim 27, Ellis, Ellis, Yoshida and Nobakht disclose all of the limitations of claim 1, but fail to teach illuminating LEDs corresponding to the appropriate buttons.

Dustin discloses a “Light” Button that illuminates buttons on a remote control **(see Column 4, Lines 6-8)**.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the web-enabled cellular phone, as taught by Ellis, Ellis, Yoshida and Nobakht, using the illuminated buttons, as taught by Dustin, for the purpose of allowing a user to operate the remote control/web-enabled cellular phone in a darkened room **(see Column 4, Lines 7-8 of Dustin)**.

Referring to claim 29, see the rejection of claim 27.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2421

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Primary Examiner
Art Unit 2421

April 14, 2011